Introduction to the 2018–2019 Edition

Every edition of the Patent Law Handbook provides topical discussions of U.S. patent law issues. With respect to a particular consideration, any pertinent constitutional, statutory and/or regulatory authority is presented along with an overview of the corresponding jurisprudence. Where the U.S. Supreme Court and/or the U.S. Court of Appeals for the Federal Circuit has decided an appeal on a specific patent law issue during the period from June 2017 through May 2018, a detailed consideration of that decision is also provided as new material in this edition. In addition, certain regional circuit and state court opinions related to patent law issues are also presented.

In particular, during this past publication cycle, the U.S. Supreme Court decided three patent appeals from the U.S. Court of Appeals for the Federal Circuit from June 2017-May 2018. The U.S. Supreme Court decided a fourth case in June 2018. These decisions addressed issues including: remedies available under the Biologics Price Competition and Innovation Act of 2009 (BPCIA); the constitutionality of inter partes reviews under Article III and the Seventh Amendment; the scope of inter partes reviews that are instituted and the impropriety of the PTAB instituting only as to some but not all of the claims challenged; and entitlement to infringement damages based on sales of products overseas that were made in the United States and shipped abroad. These cases are discussed in the respective substantive chapters as well as collectively being presented in Chapter 10 under the Supreme Court section of that chapter.

Among the significant decisions of the U.S. Court of Appeals for the Federal Circuit were issues involving the jurisprudence pertaining to unenforceability, damages, exceptional cases, the on-sale bar, and further refinement of the law pertaining to patent venue following the Supreme Court’s decision in T.C. Heartland from the previous year. A robust jurisprudential development also continues with respect to procedural aspects of inter partes review and covered business method review including with regard to standing to appeal Board decisions, intervention by the U.S.P.T.O., and
burdens of proof and persuasion as to, for example, amendments to patent claims under review. The Federal Circuit also provided further discussion regarding substantive issues relating to patentable subject matter and obviousness. Decisions from the regional U.S. courts of appeals also helped to further refine the law related to antitrust issues pertaining to patent rights, particularly in the realm of pharmaceutical patents.

In this edition, we have also added sections in Chapter 9 pertaining to patent issues litigated in the U.S. Tax Court and the U.S. Federal Trade Commission.